

REMARKS/ARGUMENTS

Claims 1-17 and 19-21 are pending in the application. By the Amendment, claims 1, 2-5, 7, 8, 10-12, and 14-17 are amended, new claims 19-21 are added, and claim 18 is cancelled without prejudice or disclaimer of the subject matter therein. It is believed that no new matter has been introduced into the application. Support for the claims can be found throughout the original specification, including the original claims, and the drawings.

Reconsideration of the application is respectfully requested for at least the following reasons.

Applicant thanks the Examiner for the indication that claims 12, 13, 17, and 18 contain allowable subject matter. However, for at least the following reasons, Applicant respectfully submits that all pending claims are in condition for allowance.

The Office Action, at page 2, rejects claims 1-4 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,662,023 to Helle. Because Helle fails to disclose all of the features of the claims, the rejection is respectfully traversed.

With respect to claim 1, Applicant respectfully submits that subject matter indicated as allowable in claim 13 is incorporated in claim 1 for the sole purpose of expediting prosecution of the application. Therefore, claim 1 defines patentable subject matter.

For at least the above reasons, Applicant respectfully submits that claim 1 is allowable. Claims 2-4 depend, directly or indirectly, from claim 1, and thus are allowable for at least the same reasons, as well as additional patentable features recited therein and the combination

thereof. Withdrawal of the rejection is thus respectfully requested.

The Office Action, at page 4, rejects claims 5-11 under 35 U.S.C. § 103(a) as unpatentable over Helle in view of U.S. Patent No. 6,289,214 to Backstrom. The Office Action, at page 8, rejects claims 14-16 under 35 U.S.C. § 103(a) as unpatentable over Helle in view of Backstrom and in further view of U.S. Patent No. 6,198,929 to Krishnamurthi et al. (hereinafter “Krishnamurthi”). Because the references, individually or in combination, fail to disclose or suggest all of the features of the claims, the rejections are respectfully traversed.

With respect to claims 5-7, independent claim 5 is directed to a method for preventing use of a mobile communication terminal, including features of turning off an LCD power by the terminal. Applicant respectfully submits that at least such features are not disclosed or suggested by Helle, Backstrom, or the combination thereof.

The Office Action, at page 5, acknowledges that Helle does not teach turning off LCD power by the terminal. However, the Office Action asserts that Backstrom discloses SMS deactivation which corresponds to a “turning off” message being communicated to a remote mobile radio telephone. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to modify the method of Helle by Backstrom to include a keyword command that instructs the terminal to be turned off to prevent usage thereof. For at least the following reasons, Applicant respectfully submits that the Office Action fails to establish a *prima facie* case of obviousness for claim 5 based upon the suggested combination.

As stated in MPEP § 2143.01, if a proposed modification or combination of references

would render the prior art invention being modified unsatisfactory for its intended purpose, then no motivation or suggestion exists to combine the references. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed.Cir.1984). Applicant respectfully submits that combining the references in the manner suggested by the Office Action would render the method of Helle unsatisfactory for its intended purpose and thus the requisite motivation or suggestion to combine the references is lacking.

In more detail, Applicant respectfully submits that Helle is directed to a method and apparatus for controlling a mobile phone when the mobile phone has been lost or stolen to prevent its use “except to help the owner find it.” Abstract and column 1, lines 45 and 46 (emphasis added). The means for accomplishing the intended purpose of Helle to enable recovery of the phone, are 1) displaying contact information on the screen of the mobile phone, 2) allowing only a displayed contact number and emergency numbers to be called from the mobile phone, and 3) transmitting location and phone usage information from the mobile phone. Abstract and column 1, lines 49-58. Accordingly, Helle discloses a mobile phone 10 that includes security and control modules 28 having an owner information display module 52, a remote-controlled secure mode module 54, and a status message module 56. See Figures 1 and 2.

As disclosed in Helle, the owner information display module 52 displays messages with owner information in the mobile telephone, and allows limited use of the mobile phone to place calls to the displayed number (as well as emergency calls). Column 3, lines 10-34. The remote-

controlled secure mode module 54 limits use of the mobile phone for placement of calls to the displayed number. The status message module 56 sends phone location or usage data upon receiving a request. Column 4, lines 53-55 and 65-67, and column 5, lines 8-10. Thus, Applicant respectfully submits that every method disclosed for controlling the mobile phone to prevent its use and enable its recovery, requires that the phone be able to display messages. Accordingly, modifying the method of Helle by Backstrom to deactivate the mobile telephone would defeat the intended purpose of Helle by preventing recovery of the mobile phone in every manner disclosed.

Further, as stated in MPEP § 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention, where some teaching, suggestion, or motivation to do so is found either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that references can be combined or modified, which Applicant submits here they cannot, does not render the resulted combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Because the Office Action fails to assert that either reference contains such motivation, a *prima facie* case of obvious has not been made. Further, Applicant respectfully submits that with the LCD power off contact information could not be displayed. Therefore, contact numbers could not be called, which would prevent the intended purpose of getting the lost phone back to the

owner. See Abstract of Helle.

For at least the reasons set forth above, Applicant respectfully submits that claim 5 is allowable. Claims 6 and 7 depend from claim 5, and are allowable for at least the same reasons, as well as additional patentable features recited therein and the combinations thereof. Withdrawal of the rejection is thus respectfully requested.

With respect to claims 8-13, Applicant respectfully submits that subject matter indicated as allowable in claim 12 is incorporated in independent claim 8 for the sole purpose of expediting prosecution of the application. Therefore, claim 8 defines patentable subject matter.

For at least the above reasons, Applicant respectfully submits that claim 8 is allowable. Claims 9-13 depend, directly or indirectly, from claim 8, and thus are allowable for at least the same reasons, as well as additional patentable features recited therein and the combinations thereof. Withdrawal of the rejection is thus respectfully requested.

With respect to claims 14 and 15, Applicant respectfully submits that subject matter indicated as allowable in claim 18 is incorporated in independent claim 14 for the sole purpose of expediting prosecution of the application. Therefore, claim 14 defines patentable subject matter.

For at least the above reasons, Applicant respectfully submits that claim 14 is allowable. Claims 15 and 16 depend from claim 14, and thus are allowable for at least these same reasons, as well as additional patentable features recited therein and the combinations thereof. Withdrawal of the rejection is thus respectfully requested.

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Applicant respectfully submits that new claims 19-21 are allowable for at least reasons similar to claim 14, as well as additional patentable features recited therein and the combinations thereof. Allowance of claims 19-21 is thus earnestly solicited.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, **Garth D. Richmond**, at the telephone number listed below. Favorable consideration and prompt allowance are earnestly solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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